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May 7, 2004
Date

Bridget J. Brinkman
Name

Signature

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OFFICIAL

Case 8322R

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of: :
JUNAN KAO ET AL. : Confirmation No.: 6333
Serial No.: 09/715,354 : Group Art Unit: 1731
Filed: November 17, 2000 : Examiner: Peter Chin
For: TENSION ACTIVATABLE SUBSTRATE

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Dear Sir:

This Reply Brief is in response to the Examiner's Answer mailed 3/8/2004.

Status of Claims:

Appellant gratefully acknowledges the withdrawal by the Examiner of the rejection of claims 1-5, 15 and 16 under 35 USC § 102(b) and the rejection of claims 6, 7, and 17 under 35 USC §103(a) in view of Appellant's brief.

The Examiner's Answer provides that the status of claims set forth in Appellant's Brief is correct. Appellant therefore presumes that the only issue remaining is the rejection of claims 1, 6-20, 24, and 25 under 35 USC §112 P1. (The Examiner's Answer provides that claims 1-20, 24 and 25 are rejected under 35 USC §112 P1 which differs from all previous groupings of claims rejected under 35 USC 112 P1.)

Issue:

I. Whether Claims 1, 6-20, 24 and 25 are properly rejected under 35 U.S.C. §112 first paragraph, as being based upon a disclosure which is non-enabling.

Argument:

Claims 1, 6-20, 24 and 25 are rejected under 35 U.S.C. §112, first paragraph, as based on a disclosure which is not enabling. The Examiner's Answer provides that this rejection is based upon the scope of enablement. Appellant submits that the specification

provides sufficient details to enable one of skill in the art to make and use the claimed tissue papers.

Appellant acknowledges that the scope of the claims must be less than or equal to the scope of the specification, *Nat'l Recovery Techs., Inc. v. Magnetic Separation Sys.*, 166 F.3d 1190, 1196 (Fed. Cir. 1999). However, the law is clear that the enablement requirement is met if the description enables any mode of making and using the invention. See *Durel Corp. v. Osram Sylvania Inc.* 256 F.3d 1298, 1308, 59 USPQ2d 1238, 1244 (Fed. Cir. 2001). Appellant submits that the description of the instant application discloses at least one method of making and using the tissue paper that satisfies the stated claim limitations. (Spec. pages 9-20) thereby satisfying the enablement requirement of 35 USC §112 P1.

Appellant teaches how to make exemplary underlying substrates for example, on page 10 line 1 to page 11, line 10, as well as page 20 lines 11 - 20. Appellant teaches exemplary details of lines of weakness that may be imparted to the underlying substrate to achieve the limitations of the claims, at least one way of imparting these lines of weakness to the underlying substrate, and how to activate the substrate for example, on pages 11 - 20. Accordingly, Appellant's claims meet the enablement standard.

The Examiner has not provided any indication that tissue papers made according to the description of the invention lack the features of the invention as claimed. Instead, the Examiner seeks to require Appellant to import additional limitations from the specification into the claims based upon an enablement rejection.

The Examiner argues that "The presence of apertures, perforations, slits, or cuts critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure." The Examiner refers to page 9 of the specification. Appellant respectfully submits that as indicated by the Examiner, the presence of apertures, perforations, slits, or cuts is enabled by the disclosure at the reference cited by the Examiner on page 9 of the specification.

The Examiner suggests that an element described in the specification, and claimed in dependent claims be amended into the rejected claims to satisfy the first paragraph of 35 U.S.C. §112. Appellant submits that this is an improper rejection under 35 U.S.C. §112 first paragraph, at least with respect to claims to an article of manufacture.

"As a matter of Patent Office practice, then, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms

which correspond in scope to those used in describing and defining the subject matter sought to be patented, must be taken as in compliance with the enabling requirement of the first paragraph of § 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. *In ReMarzocchi*, 439 F.2d 220, 224 (CCPA 1971).

Appellant claims tissue papers having particular properties. As cited above, Appellant's specification teaches how to make and use the full scope of the claimed tissue papers thereby satisfying the enablement requirement. The Examiner does not argue that any limitation of the invention as claimed is not enabled, but appears to argue instead that the invention as described is not claimed. The Examiner has set forth no reason to doubt the objective truth of the statements contained in Appellant's specification. Absent a reason to doubt the truth of the statements of the specification the claims should be allowed.

The Examiner has cited *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976) in support of this rejection. In the cited case, method claims were found to be invalid for want of a step deemed by the court to be essential to the practice of the method of the invention. Appellant respectfully submits that the application of *In re Mayhew* to an article of manufacture represents an essential element test wherein the Office seeks to require Appellant to add a claim limitation on the basis that the limitation is considered essential to the invention.

The Federal Circuit has held that there is no essential element test mandating an inquiry into what an inventor considers to be essential to his invention and requiring that the claims incorporate those elements *See Amgen Inc., v Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 65 USPQ2d (BNA) 1385 (Fed. Cir. 2003) citing *Cooper Cameron Corp. v. Kvaerner Oilfield Prods. Inc.*, 291 F.3d 1317, 1323, 62 USPQ2d 1846, 1850-51 (Fed. Cir. 2002).

Appellant's specification provides sufficient teaching for a person of ordinary skill in the art to make and use the claimed invention. Accordingly, the enablement requirement of 35 U.S.C. §112 has been satisfied. Therefore Appellant requests that the rejection under 35 U.S.C. §112 first paragraph be reversed.

Conclusion

Appellant submits that the invention as claimed is novel and unobvious, as evidenced by the withdrawal of the rejections under 35 USC §§ 102(b) and 103(a). Further that a rejection of claims made under 35 USC §112 P1 for failing to claim an element deemed essential is not a proper rejection at least with respect to an article of manufacture. For the reasons set forth above, Appellant submits that the present invention is enabled. Thus, Appellant requests reversal of the rejection under 35 USC §112 P1.

Respectfully submitted,

FOR: JUNAN KAO, ET AL.

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